

Appl. No. 10/043,590
Resp. dated Oct. 10, 2003
Reply to Office Action of 09/10/2003

Remarks/Arguments

Claims 29-37 remain in this application. Claims 29-37 are the subject of a restriction requirement. Applicant elects to prosecute Group I, Claims 29-35, with traverse. Reconsideration is respectfully requested.

The Examiner required restriction to one invention under 35 USC 121 from the groups identified by the Examiner as Group I, Claims 29-35, drawn to a method of fabricating a biopolymer array from presynthesized biopolymers, classified in class 435, subclass 7.1; Group II, Claim 36, drawn to a method of shielding biosynthesis reactions and sensitive biosynthesis reactants, classified in class 436, subclass 55; and Group III, Claim 37, drawn to a shield, classified in class 436, subclass 146.

Applicant reminds the Examiner that in making the restriction requirement between the identified groups, the Examiner, at least implicitly, is acknowledging that each identified group is patentable over the other. This is so since, for any restriction, MPEP 802.01 requires that each of the subjects of the restriction must be "PATENTABLE (novel and unobvious) OVER EACH OTHER (though they may each be unpatentable because of the prior art)".

The Examiner contended that the Group I, II, and III Inventions were each distinct from the others.

With respect to the Inventions of Group I and Group II, the Examiner contended that the Inventions of Group I and II were unrelated because the different inventions require different reagents that have different functions and different effects and would produce different products/results. At least with respect to base Claim 29 of Group I and base Claim 36 of Group II, this is incorrect. Base Claims 29 recites a method of fabricating a biopolymer array that includes adding a non-miscible fluid to the array surface. Base Claim 36 recites a method of shielding biosynthesis reactions and reactants that includes applying a non-miscible fluid to one or more sites where the biosynthesis reactions take place. Therefore, the non-miscible fluid (NMF) is the same, the function of the NMF is the same and the effects of the NMF is the same.

The Examiner further contended that the method step of depositing the biopolymer solution on the array surface and linking the biopolymer to the surface of Group I Invention is not required by the claims of the Group II Invention. Further, the

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Examiner contended that the step of depositing the sensitive biosynthesis reactants through the non-miscible fluid is not required by the claims of the Group I Invention.

However, Applicant points out that at least Claims 30, 32, 34 and 35, which are dependent from base Claim 29 of the Group I Invention, state that the biopolymer solution is deposited through the non-miscible fluid (NMF) to the array surface.

Applicant respectfully submits that the end product or result of each of the Inventions of Groups I and II is a biopolymer array, which was shielded by a non-miscible fluid during array fabrication. In the Group I Invention, an array of presynthesized biopolymers is ultimately fabricated, while in the Group II Invention, an array of biopolymers is ultimately fabricated. Therefore, Applicant submits that the restriction requirement between Groups I and II should be withdrawn.

With respect to the Inventions of **Group I** and **Group III**, the Examiner contended that the Inventions of Group III (product) and Group I (process) are related as product and process of use. The Examiner further contended that the Group III and I Inventions are distinct from each other since the product as claimed can be used in a materially different process of using that product, such as the process of coating a metal substrate.

However, Applicant respectfully points out to the Examiner that the material of the substrate, whether metal or another material, is irrelevant to that claimed in the claims of Group I and Group III Inventions. Both the claims of the Group I Invention and the claim of the Group III Invention are silent on the material of the substrate. Therefore, both of the Group I and Group III Inventions are equally applicable to being used with a metal substrate. It is unclear to Applicant how using the claimed product in "the process of coating a metal substrate" is a materially different process of using the product from the process claimed in the Group I Invention. Therefore, Applicant submits that the restriction requirement between the Groups I and III Inventions should be withdrawn.

With respect to the Inventions of **Groups II** and **Group III**, the Examiner contended that the Inventions of Groups III (product) and Group II (process) are related as product and process of use. The Examiner further contended that the Group III and II Inventions are distinct from each other since the product as claimed can be used in a materially different process of using that product, such as the process of

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coating a metal substrate. This is the same contention used by the Examiner for the distinction of Groups I and III above.

Therefore, Applicant respectfully reiterates that the material of the substrate, whether metal or another material, is irrelevant to that claimed in the claims of Group II and Group III Inventions. Both the claim of the Group II Invention and the claim of the Group III Invention are silent on the material of the substrate. Therefore, both of the Group II and Group III Inventions are equally applicable to being used with a metal substrate. Applicant submits that using the claimed product in "the process of coating a metal substrate" is not a materially different process of using the product from the process claimed in the Group II Invention.

Moreover, the Invention of Group II is a method of shielding biosynthesis reactions and reactants from the ambient environment that includes applying a non-miscible fluid to one or more sites where the biosynthesis reactions take place. The Invention of Group III is a shield that protects sensitive biosynthesis reactions and biosynthesis reactants from the ambient environment that includes a non-miscible fluid applied to cover the biosynthesis reactions. The Examiner indicated that the Invention of Group II and the Invention of Group III were both classified in class 436, albeit in different subclasses. The Examiner stated that the searches required were not co-extensive and required a burdensome search. Applicant takes issue with the Examiner's statement with respect to the Groups II and III Inventions since they are in the same class 436. MPEP 803 *Restriction – When Proper* provides in part, "If the search and examination of an entire application can be made without serious burden, the examiner *must* examine it on the merits, even though it includes claims to independent or distinct inventions." (Emphasis added is the undersigned's.)

Moreover, the Examiner is asked to further reconsider the burden to a search of the Group I Invention relative to the Group II Invention and/or Group III Invention, since the classifications identified by the Examiner are close.

The Examiner is further requested to reconsider the above restrictions at least in light of MPEP 803, which further provides in part that a restriction to one of two or more claimed inventions is proper "*only if* they [the inventions] are *able to support separate patents* and they are either independent ... or distinct ...". (Emphasis added is the undersigned's.)

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In summary, Claims 29-37 pending and were restricted. Applicant elected Group I, Claims 29-35, with traverse, herein. Reconsideration in light of the above remarks is respectfully requested.

Should the Examiner have any questions regarding the above, please contact Gordon M. Stewart, Attorney for Applicant, Registration No. 30,528 at Agilent Technologies, Inc., telephone number (650) 485-2386.

Respectfully submitted,

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